

REMARKS***The Claims***

At the time the Examiner mailed the Office Action on August 21, 2003, Claims 1, 2 and 25-32 were pending in the application. In the present response, the Applicant has canceled Claim 2. As such, Claims 1 and 25-32 remain pending in the application.

Claims Rejections Under 35 U.S.C. §102(b)

In the Office Action mailed August 21, 2003, the Examiner rejected Claims 1, 2 and 25-32 under 35 U.S.C. Section 10(b) as being anticipated by DUNLAP (U.S. Patent No. 1,965,138). With respect to Claim 2, the Examiner's rejection is rendered moot by virtue of the cancellation of Claim 2. The applicant respectfully disagrees with the rejection of Claims 1 and 25-32 because DUNLAP does not disclose each and every element of the invention as claimed in Claims 1 and 25-32.

Claims 1 and 25

DUNLAP discloses a non-porous, rigid disposable insert liner, having a base, and an elevated lip, shaped to provide protection to the interior surface and lip of the underlying vessel. DUNLAP also discloses an extended perimeter for overlaying and protecting the elevated lip of the underlying vessel (DUNLAP, Figure 1).

With respect to Claim 1, DUNLAP does not disclose the element "a raised end portion ." Rather, DUNLAP discloses a raised end wall. Clearly, the raised end wall of DUNLAP is not the same as the "raised end portion" as defined by the specification, which includes raised back

wall **26** and raised side panels **22a**, **22b** (page 6, lines 9-15 and Figure 1). Applicant submits, therefore, that independent Claim 1 is unanticipated by DUNLAP. Dependent Claim 25 incorporates the limitations of independent Claim 1, and is therefore also unanticipated by the reference. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §102(b) of Claims 1 and 25 on DUNLAP.

Claims 26-28

Independent Claim 26 recites the same elements as independent Claim 1 and adds an element. Specifically, Claim 26 recites the element "a raised end portion." As noted above, DUNLAP does not disclose a raised end portion but merely a raised end wall which is not the same as a "raised end portion" as defined by the specification. Therefore, independent Claim 26 is unanticipated by DUNLAP. Dependent Claims 27 and 28 incorporate the limitations of independent Claim 26 and therefore are also unanticipated by the reference. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §102(b) of Claims 26-28 on DUNLAP.

Claims 29-32

As noted above, DUNLAP discloses a raised end wall. With respect to independent Claim 29, DUNLAP does not disclose the element "a raised enclosed canopy" as claimed in Claim 29. Clearly, the raised end wall of DUNLAP is not the same as the "raised enclosed canopy" as defined by the specification, which includes back wall **26**, side panels **22** and top panel **38** (page 8, lines 1-2; Figure 5). Applicant submits, therefore, that independent Claim 29 is unanticipated by DUNLAP. Dependent Claims 30-32 incorporate the limitations of independent

Claim 29, and are therefore also unanticipated by the reference. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §102(b) of Claims 29-32 on DUNLAP.

Claims Rejections Under 35 U.S.C. §103(a)

In the Office Action mailed August 21, 2003, the Examiner rejected Claims 1, 2 and 25-32 under 35 U.S.C. §103(a) as unpatentable over REITER (U.S. Patent No. 6,076,693) in view of DUNLAP. With respect to Claim 2, the Examiner's rejection is rendered moot by virtue of the cancellation of Claim 2. The applicant respectfully disagrees with the rejection of Claims 1 and 25-32 because the combination of references does not teach or suggest each and every element of the invention as claimed in Claims 1 and 25-32. Furthermore, the Applicant believes that the Examiner has not met the burden of proof for a *prima facie* case of obviousness and that the combination is improperly motivated by impermissible hindsight.

The Examiner states that "Reiter et al shows all the structures of the device as recited by the claims except the insert" and also states that "[i]t would have been obvious to provide the container of Reiter et al with an insert liner as taught by Dunlap in order to enhance the handling process." The Applicant respectfully submits that the Examiner's mere assertion that a prior art reference recites the claimed invention's structure, without documenting such structure, does not establish a *prima facie* case of obviousness. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP §2142. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed

invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Notwithstanding the Examiner's failure to meet the requisite burden of proof to establish a *prima facie* case of obviousness, Applicant respectfully disagrees with the Examiner's assertion. REITER discloses a molded container for transporting bulk materials, supported within an open frame. REITER teaches (col. 3, lines 28-34 and Figure 1) a hinged door 12 at one end of the container such that the bulk material can be removed from the container by lifting the opposite end (i.e., a dump truck box). REITER does not teach or suggest the use of a liner insert of any kind. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *ACS Hospital Systems, Inc. v. Montifiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

In fact, combining the liner of DUNLAP with the molded bulk container of REITER would be improper because such a combination would destroy the intended functionality of REITER. As noted above, REITER teaches a dump truck box with an unsealed hinged door at one end to empty the bulk contents of the molded container. DUNLAP teaches a liner closed and sealed on all four sides to contain a liquid (DUNLAP, Figure 1). It would be obvious to anyone having ordinary skill in the field of dump truck boxes that the use of an insert closed on all four sides, as taught by DUNLAP, would destroy the intended functionality of the dump truck box.

Even if DUNLAP could be properly combined with REITER, the combination is still void of any teaching or suggestion of a disposable insert "having a raised end portion" as

claimed in Claims 1 and 25-28, or a "raised enclosed canopy" as claimed in Claims 29-32. As noted in the Applicant's previous arguments with respect to rejections under 35 U.S.C. §102(b), DUNLAP teaches merely a raised end wall that is easily distinguished from the structures recited in Claims 1 and 25-32 of the present application.

Applicant submits, therefore, that the combination of references suggested by the Examiner cannot render obvious the Applicant's invention as claimed in Claims 1 and 25-32. Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. §103(a) of Claims 1 and 25-32 on the combination.

Serial No. 09/710,723

Page 10



RECEIVED
OCT 17 2003
TECHNOLOGY CENTER R3700

CONCLUSION

Claims 1 and 25-32 are currently pending. In view of the foregoing amendment and remarks, Applicant respectfully submits that all of the pending claims are in condition for immediate allowance. Applicant respectfully requests reconsideration of the application and allowance of the pending claims.

If the Examiner feels for any reason that direct contact with the Applicant's attorney will advance the prosecution of this case to finality, the Examiner is invited to contact the undersigned.

Respectfully submitted,

HIGGS, FLETCHER & MACK LLP
Attorneys for Applicant

Dated: Oct 10, 2003



Charles F. Reidelbach, Jr., Esq.
Registration No. 36,649

401 West A Street
Suite 2600
San Diego, CA 92101
Telephone: 619-236-1551
Facsimile: 619-696-1410
E-Mail: reidelbach@higgslaw.com